

REMARKS

Claims 17, 20-41, 47-58 and 61 are pending in the application. By the present amendment, claims 1-16, 18-19, 42-46 and 59-60 has been cancelled and claims 17, 20 and 47 rewritten into independent form to include all of the limitations of their respective base claims.

Claim Rejection under 35 U.S.C. § 103

Claims 17, 20-41, 47-58 and 61 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cline (U.S. Patent Application No. US 2001/0051835) (“Cline”) in view of Barnard (U.S. Patent No. 6,456,938) (“Barnard”). However, Applicants submit that this combination of references does not support the Examiner’s rejections of the present claims under 35 U.S.C. § 103(a). The case law is clear that in order for the U.S. Patent and Trademark Office to “establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” Manual of Patent Examining Procedure (M.P.E.P.) Section 2143.

It is well known that when combining the content of various references “there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant.” *In re Dance*, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Raynes*, 28 USPQ2d 1630, 1631 (Fed. Cir. 1993); *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). “The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Moreover, the Patent and Trademark Office can satisfy its burden of establishing obviousness “only by showing some *objective* teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teachings of the references.” *In re Fine*, 1837 F.2d 1071, 1073, 5 USPQ2d 1596 (Fed. Cir. 1988) (emphasis added) (citations omitted). The Federal Circuit in *In re Fine* stated that a “bald assertion” of substituting an element in a prior art reference would have been within the ordinary skill in the art is insufficient to support a finding of obviousness.” *Id.* at 1074.

The Federal Circuit has emphasized the requirement that the prior art must suggest the modifications necessary to achieve the claimed invention. The “mere possibility” that a prior art reference could be modified such that its use would lead to the particular result recited in a claim does not make that recited in the claim obvious “unless the prior art suggested the desirability of such a modification.” *In re Ochia*, 71 F.3d 1565, 1570, 37 USPQ2d 1127 (Fed. Cir. 1995). “Obviousness cannot be established by hindsight combination to produce the claimed invention.” *In re Dance*, 48 USPQ2d at 1637; *In re Gorman*, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

Claims 17, 20-41, 47-58 and 61 over Cline in view of Barnard

As stated above, claims 17, 20-41, 47-58 and 61 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cline in view of Barnard.

In the present case, independent claims 17, 20, 47, 53 and 61 are each directed towards the real-time or continuous distribution or communication of information to a plurality of participants during an event. While the Examiner concludes that Cline teaches the “continuous” providing of information to participants during an event, Applicants respectfully disagree, particularly as Applicants find no teaching and/or suggestion in Cline of a system, method or program that generates “real-time” or “continuous” information during an event as presently claimed. Rather, Cline is merely directed to a method and apparatus for providing golf score tabulating services and historically based event information to golfers who have completed an event or golf round. (see generally Cline, Abstract and page 4, paragraph 0050 – “the invention is designed to allow the quick result posting **after completed rounds**”) (emphasis added). As such, Cline does not teach a “real-time” based system such as the presently claimed invention.

Moreover, Applicants also find no teaching or suggestion by Cline of a transceiver adapted to receive and provide the real-time information to the participants during the event such as presently claimed. While the Examiner contends that a “WAP inherently comprises a transceiver for transferring and receiving data” (pg. 3 of Office Action), Applicants contend that this conclusion is not only unsupported by the record, but more importantly, is irrelevant to the standard of obviousness. Inherency and obviousness are entirely different concepts. *In re Rinehart*, 189 USPQ 143, 148 (CCPA 1976). Furthermore, a retrospective view of inherency is not a substitute for some teaching or suggestion which supports the selection and use of the various elements in the particular claimed combination. The critical inquiry is

whether there is something in the prior art as a whole to suggest the desirability of making the combination. *In re Newell*, 13 USPQ2d 1248 (Fed. Cir. 1989). Cline provides no suggestion of any desirability of a system, method or program comprising a real-time or continuous distribution or communication of information to a plurality of participants during an event in which a transceiver is used to receive and provide such information to the participants. Therefore, any inherent transceiving functionality relied on by the Examiner to modify Cline to reach the present invention is irrelevant and unsupportive of a rejection under 35 U.S.C. § 103.

Additionally, the deficiencies of Cline are also not resolved by Barnard which merely teaches of a personal palm-held device for uploading and downloading map and golf play information for a particular golf course. (See Barnard, Abstract). Accordingly, one skilled in the relevant art would be unable to formulate the presently claimed invention from the teachings of Cline in view of either Barnard. Specifically, in order for a combination of references to render an invention obvious, a combination of the teachings of all or any of the references must suggest, expressly or by implication, the possibility of achieving further improvement by combining such teachings along the line of the invention, *In re Sernaker*, 217 U.S.P.Q. 1, 5 (Fed. Cir. 1983). The Examiner cannot pick and choose among the individual elements of assorted prior art references to recreate the claimed invention; rather, the Examiner has the burden to show some teaching or suggestion in the references to support their use in a particular claimed combination, *Smith-Kline Diagnostics, Inc. v. Helena Laboratories Corp.*, 8 U.S.P.Q.2d 1468, 1475 (Fed. Cir. 1988). In this case, Applicants find no teaching or suggestion to make the cited combination to arrive at the invention defined by the claims presently at issue.

For at least these reasons, removal of the rejection and allowance of claims 17, 20-41, 47-58 and 61 is respectfully requested. If the Examiner should disagree with the Applicants' arguments, the Examiner is asked to kindly point out with particularity where in the cited references the limitation is expressly disclosed or taught.

Final Comments

Applicants submit that the application is now in condition for allowance and respectfully request that the same be granted. Applicants request that, if necessary, this Amendment be considered a request for an extension of time for a time appropriate for the amendment to be timely filed. Applicants request that any required fees for filing this

Amendment be charged to the account of Bose McKinney & Evans LLP, Deposit Account Number 02-3223.

Respectfully submitted,

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